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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,260	02/06/2007	Raymond G. Roth	PAT 53988W-2	4571
	7590 10/14/201 ONER GERVAIS LLP	EXAMINER		
Anne Kinsman			STEPHENSON, DANIEL P	
WORLD EXCHANGE PLAZA 100 QUEEN STREET SUITE 1100		ART UNIT	PAPER NUMBER	
OTTAWA, ON CANADA	OTTAWA, ON K1P 1J9 CANADA			
			NOTIFICATION DATE	DELIVERY MODE
			10/14/2010	ELECTRONIC

# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipinfo@blgcanada.com

	Application No.	Applicant(s)				
Office Action Comments	10/596,260	ROTH ET AL.				
Office Action Summary	Examiner	Art Unit				
	DANIEL P. STEPHENSON	3676				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
1) Responsive to communication(s) filed on 27 September 2010.						
•						
3) Since this application is in condition for allowan		secution as to the merits is				
, <del></del>	closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims						
4)⊠ Claim(s) <u>9-11,22 and 23</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>9-11,22 and 23</u> is/are rejected.						
7) Claim(s) is/are objected to.	) Claim(s) is/are objected to.					
8) Claim(s) are subject to restriction and/or	election requirement.					
Application Papers						
9)☐ The specification is objected to by the Examine						
10)⊠ The drawing(s) filed on <u>3 June '09 and 7 June '</u>	<u>06 and 27 Sep '10</u> is/are: a)⊠ ao	ccepted or b) objected to by the				
Examiner.						
Applicant may not request that any objection to the o	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correcti	Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).					
11)☐ The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.				
Priority under 35 U.S.C. § 119						
12)⊠ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a)□ All b)□ Some * c)⊠ None of:						
1. Certified copies of the priority documents have been received.						
<ul><li>2. Certified copies of the priority documents have been received in Application No</li></ul>						
3. Copies of the certified copies of the priority documents have been received in Application No						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
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Attachment(s)  1) Notice of References Cited (PTO-892)  4) Interview Summary (PTO-413)						
Notice of References Cited (PTO-892)     Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) 🔛 Interview Summary Paper No(s)/Mail Da					
3) Information Disclosure Statement(s) (PTO/SB/08)	5) 🔲 Notice of Informal Pa					
Paper No(s)/Mail Date	6)					

### **DETAILED ACTION**

## Claim Rejections - 35 USC § 101

#### 1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-11, 22, and 23 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Analysis of the Applicant's disclosure reveals the following to the Examiner:

- The pullhead 24 must move from right to left with respect to figure 2 (i.e., towards the motor 16)
- The pullhead 24 creates a borehole that has a diameter approximately equal to the diameter of the pullhead at second end 26 (page 7, lines 15-21)
- Slurry jets 50 release drilling fluid from the rear of the pullhead and into the annulus between the steel connect 28 (and/or casing 30) and the borehole previously drilled by the pullhead (figures 4 and 6); thus the slurry created by the mixing of the drilling fluid and the mud must be located in the annulus *behind* the pullhead (emphasis added)

Therefore, it appears that the Applicant's claimed invention cannot operate as currently claimed. If the diameter of the borehole is approximately equal to the diameter of the pullhead and the slurry jets release the drilling fluid into the annulus behind the pullhead, then it is unclear to the Examiner how the slurry created by the drilling fluid then could ever be forced to leave the annulus behind the pullhead, travel between the borehole and the pullhead (which are said to be of diameters that are approximately equal), and then be made to enter through the flutes 48 of the

pullhead so that the slurry can then travel to and through the interior of the pipe being laid.

Without any specific structure or disclosure to the contrary, it appears that the drilling fluid leaving the slurry jets 50 will mix with the mud in the annulus behind the pullhead to create a slurry, said slurry will then either be simply left in the borehole and/or travel along the borehole in a direction opposite to that of the pullhead. Thus, again, it does not appear that the Applicant's disclosed invention can operate in the claimed manner because it does not appear to be physically possible for the slurry to be guided directly through the pullhead to an interior of the pipe.

## Response to Arguments

2. The use of evidence, in the form of videos, within the remarks is not a sufficient argument. Evidence should be submitted in the form of an affidavit under 37 CFR 1.131 or 1.132, indicating who is making the declaration. While the videos do show something that may be the applicant's device and method as claimed, it is not a persuasive argument, as it does not show specifically what is occurring at the bit, but merely a pipe ejecting what appears to be a slurry of fluid and the preparation and binning of drilling under a river.

#### Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. STEPHENSON whose telephone number is (571)272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shane Bomar can be reached on (571) 272-7026. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Art Unit: 3676

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DANIEL P STEPHENSON/ Primary Examiner, Art Unit 3676